

REMARKS

Claims 1-21 are all the claims presently pending in the application.

The contents of the present Office Action are addressed in the following discussion.

I. THE ALLOWABLE SUBJECT MATTER

In the present Office Action, the Office admits that claims 2-10 and 14-16 are objected as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants appreciate and acknowledge the Office's notification. However, Applicants respectfully submit that all presently pending claims are in condition for allowance.

II. THE PRIOR ART REJECTION – The Alleged Chung and Bae Combination

Claims 1, 11-13, and 17-21 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over by Chung et al. (U.S. Patent Publication No. 2005/0078947 A1) in view of Bae et al. (U.S. Patent No. 7,356,248 B2). Chung discloses an information storage medium storing subtitle and video mapping information. (Chung at Abstract.) Bae discloses an apparatus and method of reproducing a subtitle recorded in a digital versatile disk player. (Bae at Abstract.) The Office alleges that the combination of Chung and Bae makes the independent claims obvious.

However, Applicants respectfully disagree and submit that the Office fails to meet the initial burden of establishing obviousness. As a result, a prima facie case of obviousness is not established. Thus, since the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness, the burden to establish patentability is not shifted to Applicants.

Specifically, MPEP § 2142 provides

[t]he legal concept of *prima facie* obviousness is a procedural tool of examination
It allocates who has the burden of going forward with production of evidence
The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness

(emphasis added).

Specifically, the Office admits that Chung fails to teach a non-transitory computer-readable storage medium, “comprising . . . a plurality of subtitle data items corresponding to the playback routes and configured to support a random search for a subtitle”, as is recited, for example, in claim

1 and somewhat similarly with respect to the apparatus of claim 12 and the method of claim 17. (Office Action at page 3, first paragraph.)

The Office alleges that Bae makes up for the above-referenced deficiency of Chung. The Office specifically refers to claim 1 of Bae as allegedly teaching the above-referenced limitation. However, the Office is in clear error with respect to this allegation.

Specifically, the method of claim 1 of Bae includes, “if a subtitle of a language wanted by a user is not provided on the DVD, allowing the user to search subtitle information received in a subtitle information storing section of the DVD player . . .” This is the only portion of claim 1 of Bae that recites any sort of search.

However, as is clearly determined by the above-referenced portion of Bae, the search of Bae is performed solely with respect to the DVD player and not the DVD. Further, the search is performed after it is confirmed that the desired subtitle is not found on the DVD. Moreover, not one portion of Bae remotely teaches or suggests supporting a random search for a subtitle. In fact, Bae teaches away from the independent claims by providing that a user is allowed to search subtitle information.

In stark contrast to Bae, the non-transitory computer-readable storage medium of the present claims includes a plurality of subtitle data items corresponding to the playback routes and configured to support a random search for a subtitle. Indeed, the method and apparatus are directed to reproducing or reproducing data on a storage medium. Thus, Bae fails to teach or suggest the above-referenced feature of the independent claims, even assuming (arguendo) one having ordinary skill in the art would combine Chung and Bae.

For all of the above-referenced reasons, the Office fails to meet the initial burden of establishing obviousness. As a result, a prima facie case of obviousness is not established. Thus, since the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness, the burden to establish patentability is not shifted to Applicants.

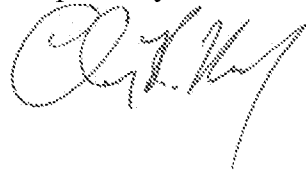
Therefore, Applicants respectfully request the Office to reconsider and withdraw this rejection.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicants submit that claims 1-21, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Office is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Office find the application to be other than in condition for allowance, the Office is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

Respectfully Submitted,



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